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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,918	11/20/2000	Jay S. Walker	98-010-C1	9324
22927 7590 01/05/2011 WALKER DIGITAL MANAGEMENT, LLC 2 HIGH RIDGE PARK STAMFORD, CT 06905				
EXAMINER				
LEIVA, FRANK M				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JAY S. WALKER, JAMES A. JORASCH, and  
MAGDALENA MIK

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Appeal 2009-009986  
Application 09/716,918  
Technology Center 3700

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Before JOHN C. KERINS, MICHAEL W. O'NEILL, and KEN B.  
BARRETT, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

## STATEMENT OF THE CASE

Jay S. Walker et al. (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision finally rejecting claims 50-54, 56-58, 60-62, 64-69, and 71-77 under 35 U.S.C. § 102(e) as being anticipated by Barrie (US 5,833,537, issued Nov. 10, 1998), claims 55, 59, and 63 under 35 U.S.C. § 103(a) as being unpatentable in view of Barrie and Weiss (US 6,165,071, issued Dec. 26, 2000), and claim 70 as being unpatentable in view of Barrie alone.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

### *The Invention*

The claims on appeal relate to a gaming machine having the ability to determine a bonus payout based on a running count of tracked symbol occurrences. Spec. 1: 6-8.

Claim 50, reproduced below, is illustrative of the subject matter on appeal.

50. A method comprising:  
generating an outcome represented by a plurality of symbols;  
counting occurrences of at least one tracked symbol, thereby determining a number of occurrences of the at least one tracked symbol counted in accordance with an expiration condition;  
determining whether the number is at least a minimum number; and

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<sup>2</sup> While Appellants addressed all the claims pending, Appellants do not separately address the rejection of claims 55, 59, and 63. This is understandable since the Examiner omitted listing the grounds of rejection in the Final Office Action, mailed Jan. 8, 2008; *cf.* Ans. 2 (confirming that Appellants' statement of the grounds of rejection on appeal (App. Br. 13, which does not list the rejection of claims 55, 59, and 63) is correct). Appellants' omission does not effect our disposition of this appeal.

providing, if the number is at least a minimum number, a bonus payout based on the number of occurrences of the at least one tracked symbol,

wherein the expiration condition defines at least one of

(i) a number of plays, from a play in which an occurrence occurs, after which the occurrence expires and

(ii) a period of time, from a time at which an occurrence occurs, after which the occurrence expires, and further

wherein the expiration condition is associated with each respective occurrence, such that a first occurrence may expire at a first time and a second occurrence may expire at a second time that is different from the first time.

## DISCUSSION

We agree with Appellants that the Examiner has failed to establish that claims 50-54, 56-58, 60-62, 64-69, and 71-77 lack novelty inasmuch as the Examiner has failed to identify where all of the claimed limitations are disclosed within one embodiment of Barrie. Instead, the Examiner's rejection and response "picks and chooses" features from multiple embodiments that are not disclosed as working together, but rather are alternative embodiments, and misconstrues Barrie's disclosure in order to improperly attribute the Appellants' claimed terminology to Barrie's disclosure. Thus, the Examiner's anticipation rejection is based on the building of an improper foundation with an inappropriate framing to bolster an unsupportable "argument" for anticipation.

The Examiner fails to remedy the aforementioned error within the obviousness rejections.

DECISION

Based on the foregoing, the Examiner's decision to reject the claims pending on appeal is reversed.

REVERSED

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